

In re application of: KRAMER, M., et al.
Appln. No.: 09/787,559
Examiner: Angell, J.

REMARKS

I. Introduction

Claims 2, 3, 8-10, 17 and 24 are pending in the subject application. Claims 1, 4-7, 11-16, 18-23 and 25-28 have been cancelled without prejudice or disclaimer. Claims 2, 3, 8, 10, 17, and 24, have been amended to more particularly point out and distinctly claim the Applicants' invention. Support for the amendments may be found throughout the specification. Applicants submit that the amendments place the remaining claims in condition for allowance and respectfully request their entry. No new matter has been added.

Applicants reserve the right to pursue the cancelled subject matter in one or more Continuation or Divisional applications. All claim amendments or cancellations are made herein for the sole purpose of expediting prosecution and are not to be construed as an acquiescence to any of the rejections/objections set forth in the Office Action. Applicants reserve the right to pursue the claims as originally filed, or substantially similar claims, in this or one or more continuation patent applications.

II. Claim Rejections under 35 U.S.C. § 102(b)

A. *Rejection of Claims 2, 3, and 17 as being anticipated by Boehringer Mannheim*

Claims 2, 3, and 17, were rejected under 35 U.S.C. § 102(b) as being anticipated by an offer for sale on page 95 of the 1997 Boehringer Mannheim Catalog. The Office Action asserts that in claim 2, the "nucleotide sequence complementary to one of SEQ ID No: 1 or SEQ ID NO: 4" includes any nucleic acid sequence that is complementary to any part of either sequence. The Office Action further asserts that the 1997 Boehringer Mannheim Catalog offered a "mixture of hexamer nucleotides of all possible sequences for random primed DNA labeling." Applicants respectfully disagree that an offer for a mixture of all possible hexamer nucleotides anticipates

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claim 2, because the offer does not specifically list the sequence with 100% identity to a portion of SEQ ID NO: 1 or SEQ ID NO: 4, and there exist at least 6^6 or 46,656 species of sequences within the genus of a hexamer nucleotide. The Examiner is respectfully reminded that a generic formula encompassing a vast number of compounds cannot anticipate a claim to a particular species. MPEP 2131.02; *In re Petering*, 301 F.2d 676, 133 USPQ 275 (CCPA 1962). However, in order to expedite prosecution, Applicants have removed language referring to sequences complementary to the disclosed sequences, and inserted language reciting “the antisense strand of SEQ ID NO: 1 or SEQ ID NO: 4.” In this manner, Applicants claim the strand complementary to the entirety of a strand of either disclosed SEQ ID, and respectfully traverse the rejection based upon the Office Action’s reference to a possible disclose of a strand complementary to only a portion of a disclosed SEQ ID. Based on the foregoing, Applicants request the withdrawal of the instant rejection.

B. Rejection of Claims 2, 3, 4, and 17 as being anticipated by Mierendorf et al. (U.S. Patent 5,629,179).

The Office Action further asserts that Mierendorf teaches every possible octamer, one of which could anticipate a portion of a strand complimentary to SEQ ID NO: 1 or SEQ ID No: 4. Applicants respectfully disagree that a genus, such as octamers, with a vast number of species, can anticipate a specific species. However, Applicants respectfully assert that the amendment as described in § II (A) limiting the complementary strands to the antisense SEQ ID NOs: 1 and 4, traverses the Examiner’s rejection. Based on the foregoing, Applicants request the gracious withdrawal of the instant rejection.

For the foregoing reasons, it is respectfully submitted that the pending claims are patentable over the cited reference. Applicants submit that the foregoing fully addresses the Examiner’s rejections under 35 U.S.C. §102 and respectfully request its withdrawal.

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Appln. No.: 09/787,559
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III. Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 2-3, 8-11, 17 and 24, have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter with Applicants regard as the invention.

In response to the rejection of claims 2, 3 and 8-11, Applicants have amended claim 2 to recite “wherein said nucleic acid ~~protein~~ has a nucleotide sequence of SEQ ID NO: 1 or SEQ ID NO: 4.” No new matter has been added by virtue of this amendment and its entry is respectfully requested. It is noted that claims 3 and 8-11 were rejected due to their dependency on claim 2. In view of the proceeding amendment, Applicants respectfully request reconsideration and withdrawal of the instant rejection.

Claim 11 is rejected under 35 U.S.C. § 112, second paragraph. Claim 11 has now been cancelled, and any basis for this rejection is now thereby obviated.

Claims 17 and 24 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite due to the use of the term “in particular.” In response, Applicants have amended claims 17 and 24 to delete the term “in particular.” Applicants have also removed the phrase from claim 10. Applicants have added new claims 29-31 to maintain the scope of the disclosed subject matter. Support for the new claims may be found in original claims 10, 17, and 24, and in the specification as filed.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

IV. Claim Rejections Under 35 U.S.C. § 112, First Paragraph

Claims 10 and 11 are rejected under 35 U.S.C. § 112, first paragraph. The Office Action asserts that the specification is enabling only for an isolated transformed host cell but not for a non-isolated transformed host cell. Applicants respectfully disagree with the Examiner, however, in order to expedite prosecution, claim 10 has been amended to recite the term

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Appln. No.: 09/787,559
Examiner: Angell, J.

"isolated," and claim 11 has been cancelled. In view thereof, Applicants respectfully request reconsideration and withdrawal of the instant rejection.

Claim 24 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In response, Applicants have amended claim 24 to remove reference to the term "splice variants." In view thereof, Applicants respectfully request reconsideration and withdrawal of the instant rejection.

V. Claim Objections

Claim 2 is objected to due to informalities. Applicants have amended the claim accordingly. In view thereof, Applicants respectfully request reconsideration and withdrawal of the instant objection.

The Office Action further objects to claim 11. Claim 11 has been cancelled, so any grounds for this rejection are now moot.

Claim 8 has been objected to due to the Examiner's perceived awkwardness of the phrase, "said DNA vector molecule expressing protein pKe#122.." Applicants respectfully disagree that the phrase would be unclear to one of skill in the art. However, in order to expedite prosecution, Applicants largely adopt the suggestion set forth in the Office Action and amend claim 8 to recite "wherein said DNA vector expresses protein pKe#122" Applicants respectfully assert any grounds for the objection are eliminated by this amendment.

In view of the foregoing, Applicants respectfully request reconsideration and removal of all objections.

VI. Conclusion

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's

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amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-0951 and please credit any excess fees to such deposit account.

Respectfully submitted,

AKERMAN SENTERFITT

Date: November 2, 2006

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Docket No. 4007-001